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PATENT
660057-2010

EP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : CROWE ET AL.

Serial No. : 10/047,383

For : **APPARATUS FOR STIMULATING A MUSCLE OF A
SUBJECT**

Filed : January 14, 2002

Examiner : GEORGE EVANISKO

Art Unit : 3762

745 Fifth Avenue
New York, NY 10151

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**, on October 1, 2004.

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(Name of Applicant, Assignee or Registered Representative)



Signature

January 6, 2005

Date of Signature

RESPONSE TO REQUIREMENT FOR SPECIES ELECTION/RESTRICTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated December 12, 2004 setting a one-month period for reply, Applicants provisionally elect, with traverse, the following species for further prosecution on the merits:

Reconsideration and withdrawal of the requirement for species election are respectfully requested in view of the remarks herewith.

The Examiner characterized and required election of one the recited embodiments from each of the following groups under 35 U.S.C. §121:

Group 1 – embodiments 1 and 2, represented by the system or method of delivering a plurality of single pulses or burst of pulses, respectively.

Group 2 – embodiments 3-7, represented by a signal generator and electrode system (or corresponding method) comprising a single pulse (claims 27-20 and 93-95), a plurality of bursts (claims 30-41 and 96-110), the electrode in a garment (claims 45-52 and 111-118), the amplitude to allow normal sleep (claims 53-55 and 119-121), and a plurality of electrodes (claims 60-66 and 126-132), respectively.

Group 3 – embodiments 8-10, represented by the different monitors comprising hear rate, caloric, or accelerometer, respectively.

Group 4 – embodiments 11-12, represented by applying the electrodes to the same limb or different limbs, respectively.

Examiner's communication of December 7, 2004, has clarified that an election must be made of at least on embodiment from each of these Groups, accordingly Applicants elect the following claims for further prosecution on the merits:

From Group 1 - Embodiment 1, which is directed to a system of method of delivering a plurality of single pulses and includes claims – 1-10, 15-26, 42-44, 67-76, 81-92, and 108-110;

From Group 2 – Embodiment 3, which is directed to a signal generator and electrode system (or corresponding method) and includes claims 27-29 and 93-95;

From Group 3 – Embodiment 8, which is directed to an embodiment comprising a hear rate monitor and includes claims 56 and 57; and .

From Group 4 – It is Applicant's attorney's our understanding that embodiments 11 and 12 are directed to dependent claims of the methods described in independent claims 60 and 126. As a result, it is believed that no election can be made with respect to Group 4 in view of the elections made with respect to Group 2.

Nonetheless, Applicants maintain their traversal of the election requirement because the requirement, respectfully, lacks merit. The MPEP lists two criteria for a proper Restriction Requirement. First, the invention must be independent or distinct (MPEP §803). Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden,...even though it includes claims to distinct or independent inventions.” *Id.*

Neither of these criteria is present here. The claims of the instant application represent a web of knowledge and continuity of effort that merits examination in a single application. Further, it is unlikely that the Examiner would be unduly burdened by searching and examining both groups together. For example, a search and examination of any of the embodiments of Group 1, Group 2, Group 3, or Group 4 would invariably result in overlapping subject matter. It would, therefore, be prudent for the Examiner to search and examine the subject matter of Groups 1-4 in a simultaneous manner, not only for purposes of efficiency and temporal economy, but also to conserve PTO resources. Consequently, it is believed that the requirement for election is improper.

Applicants reserve the right to have un-elected species considered by the Examiner upon allowance of a generic claim, and further reserve the right to file one or more divisional applications directed to the un-elected groups.

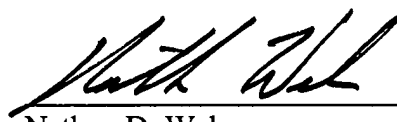
CONCLUSION

Accordingly, reconsideration and withdrawal of the election of species requirement are respectfully requested, and an early action on the merits is earnestly solicited.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment in this Petition fee to Deposit Account No. 50-0320.

Respectfully submitted,
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By:



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